

### **REMARKS**

Claims 1, 3-7, 9, and 11-20 are pending in the present application. Claims 1, 3-7, 9, and 11-20 have been rejected. Reconsideration and allowance is respectfully requested in view of the amendments and the following remarks.

#### **The 35 U.S.C. § 103 Rejections**

Claims 1, 3-7, 9 and 11-20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Dubin (U.S. Patent No. 5,284,492) in view of WO 95/27021 and Schwab (U.S. Patent 5,669,938). The Examiner contends that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to add the organic nitrate ignition improver of Schwab and the anti-freeze inhibitor of WO ‘021 to the diesel fuel emulsions of Dubin in order to provide their known benefits.” Applicants respectfully disagree with the Examiner’s contentions.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Identification of prior art statements that, in abstract, appear to suggest claimed limitations does not establish *prima facie* case of obviousness without finding as to specific understanding or principle within knowledge of skilled artisans that would have motivated one with no knowledge of the invention at issue to make a combination in the manner claimed. *In re Kotzab*, 55 USPQ2d 1314, (Fed. Cir. 2000)

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *In re Kotzab*, 55 USPQ2d 1317, (Fed. Cir. 2000)

The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Keller*, 208 USPQ 871, 881 (CCPA 1981).

Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. *In re Kotzab*, 55 USPQ2d 1317, (Fed. Cir. 2000) Broad conclusory statements standing alone are not evidence. *In re Kotzab*, 55 USPQ2d 1317, (Fed. Cir. 2000).

The Examiner has stated that it would have been obvious to one having ordinary skill in the art to combine the references “to provide their known benefits.” The Examiner has not provided a specific motivation to combine the references as required. There is no suggestion or incentive in the Dubin reference that would have motivated the skilled artisan to modify Dubin or to combine Dubin with the Schwab and WO `021 references. Further, the Examiner has merely stated that the proposed modification of the prior art would have been completed to provide the known benefits of the compounds. The proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. The Examiner has not demonstrated that the modification would have had a reasonable expectation of success. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Since the Applicants have traversed the Examiner’s rejection, Applicants request that the Examiner provide an Affidavit or other evidence of the motivation to combine the references, as required by MPEP 2144.03.

The argument and evidence set forth above is equally applicable here. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir.

1988). Since the independent Claim 1 is non-obvious, then the dependent Claims 3-7, 9, and 11-20 must also be non-obvious.

Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1, 3-7, 9 and 11-20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Peter-Hoblyn et al. (U.S. Patent No. 5,743,922) in view of WO 95/27021 and Schwab. The Examiner contends that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to add the organic nitrate ignition improver of Schwab and the anti-freeze inhibitor of WO `021 to the diesel fuel emulsions of Peter in order to provide their known benefits.” Applicants respectfully disagree with the Examiner’s contentions.

As stated above, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Identification of prior art statements that, in abstract, appear to suggest claimed limitations does not establish *prima facie* case of obviousness without finding as to specific understanding or principle within knowledge of skilled artisans that would have motivated one with no knowledge of the invention at issue to make a combination in the manner claimed. *In re Kotzab*, 55 USPQ2d 1314, (Fed. Cir. 2000)

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *In re Kotzab*, 55 USPQ2d 1317, (Fed. Cir. 2000)

The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Keller*, 208 USPQ 871, 881 (CCPA 1981).

Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. *In re Kotzab*, 55 USPQ2d 1317, (Fed. Cir. 2000) Broad conclusory statements standing alone are not evidence. *In re Kotzab*, 55 USPQ2d 1317, (Fed. Cir. 2000).

The Examiner has stated that it would have been obvious to one having ordinary skill in the art to combine the references “to provide their known benefits.” The Examiner has not provided a specific motivation to combine the references as required. There is no suggestion or incentive in the Peter-Hoblyn et al. reference that would have motivated the skilled artisan to modify Peter-Hoblyn et al. or to combine Peter-Hoblyn et al. with the Schwab and WO `021 references. Further, the Examiner has merely stated that the proposed modification of the prior art would have been completed to provide the known benefits of the compounds. The proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. The Examiner has not demonstrated that the modification would have had a reasonable expectation of success. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Since the Applicants have traversed the Examiner’s rejection, Applicants request that the Examiner provide an Affidavit or other evidence of the motivation to combine the references, as required by MPEP 2144.03.

The argument and evidence set forth above is equally applicable here. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988). Since the independent Claim 1 is non-obvious, then the dependent Claims 3-7, 9, and 11-20 must also be non-obvious.

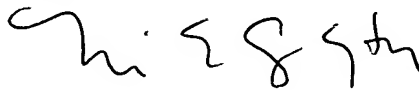
Reconsideration and withdrawal of this rejection is respectfully requested.

Request for Allowance

In view of the foregoing, consideration and an early allowance of this application are earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,  
SIERRA PATENT GROUP, LTD.



Nicole E. Coppes-Gathy  
Reg. No.: 46,640

Dated: October 8, 2003

Sierra Patent Group, Ltd.  
P.O. Box 6149  
Stateline, NV 89449  
(775) 586-9500